

REMARKS / ARGUMENTS

Summary of Amendments to the Claims

Claim 1 is as previously presented.

Claim 2 is original.

Claim 3 is cancelled without prejudice.

Claim 4 is as previously presented.

Claims 5 - 13 are original.

Claims 14 - 21 are cancelled without prejudice.

Claim 22 is currently amended.

Claim 23 is as previously presented.

Claims 24-25 are currently amended.

Claim 26 is as previously presented.

Claim Rejections based 35 USC §103

Claims 1 - 22.

The Office Action rejected claim 1 based on the combination of Repaci, Miles and Belt.¹ Applicant respectfully traverses this rejection. Repaci is a patent for a “shipping and display system product shipping and display strip system displaying items, or product, at retail store check out counters and high traffic areas.” Miles is a patent for “A method and apparatus for sequentially and precisely registering cut sheets for application onto advertising signatures at high speeds employs an initial roll of sheeting material.”

The Office Action states [page 9, line 5ff]:

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided to combine the references since some teaching, or suggestion to do so is found in the knowledge generally available to one of ordinary skill in the art since both references are directed towards plastic materials having an adhesive surfaces.

I. Applicant respectfully requests Examiner's reconsideration in asserting that Miles is analogous art with respect to Applicant's present invention and that Miles provides knowledge generally available to one of ordinary skill in the art. Examiner's assertion of the scope of the analogous art is too broad in that all teachings of plastic materials having adhesive surfaces would not necessarily, and in all probability does not, reside in any particular person who is skilled in the art of retail merchandising strips.

In a particular example, Miles contributes to the art of self-attaching sheets (“post-it” note type sheeting), whose function and purpose is so divergent from the functional requirements of a retail merchandising strip that one skilled in the art of retail merchandising strips would look away from the art of self-attaching sheets, given the

¹ “Claims 1,2 and 4 -13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Repaci et al. (USPN 6,109,852 [sic: 6,109,582]) in view of Miles (USPN 6,383,591) and Belt (USPN 6,405,778).”

inability of such product to support objects of substantially greater weight and/or size. Specifically, the art is directed toward supporting only the sheet structure itself onto an object of generally greater weight or size, whereas for retail merchandising strips, the opposite functionality is required. This constitutes at least one reason for one skilled in the art not to make such a combination.

Miller exemplifies the art around the time of the present invention in that even Miller does not disclose utilization of silicone coating, instead continues to use the known prior art technique of using release liner paper. Clearly, one skilled in the art would not have general knowledge of all “plastic materials having an adhesive surfaces” and, therefore, such definition of those skilled in this art is too broad for purposes of asserting obviousness.

Therefore, applicant respectfully requests reconsideration of the Examiner’s position that the art references are analogous and, therefore, an objective reason is not established to use the Miles teaching in combination with the teachings of the other references.

II. The claimed improvements do not constitute a predictable use or predictable variation of prior-art elements of Miles according to their established functions. See, *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-419, 127 S. Ct. 1727, 1740, 167 L. Ed. 2d 705 (2007) (“...a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.”). The function established in Miles (the art is directed toward supporting only the sheet structure itself onto an object of generally greater weight or size) does not render a predictable use of the prior-art

element for the claimed improvement. See, *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1326, 6/1/09 (Opinion by Circuit Judge Linn, joined by Circuit Judge Newman and Circuit Judge Bryson) (“An inference of nonobviousness is especially strong where the prior art’s teachings undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements.”).

Applicant respectfully requests reconsideration of the Examiner’s use of the Miles reference in view of the established function disclosed by Miles.

III. In response to Applicant’s arguments, the Office Action [page 8, lines 10ff] says “there is some teaching, suggestion, or motivation [to combine the references] found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art since Miles shows” coating one side of a strip with silicone to facilitate rolling and unrolling of the strip.

We note and reassert for reconsideration that combining Miles with Repaci and Belt will change the principle of operation of the prior art inventions being modified. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP §2143.01 VI, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In Miles, the art is directed toward supporting only the sheet structure itself onto an object of generally greater weight or size, whereas for retail merchandising strips, the opposite functionality is required.

Claims 2 – 21.

Claims 2 through 21 depend upon Claim 1 and should be allowable should the Examiner find Claim 1 to be allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Claim 22.

I. The arguments against using Miles as a reference in combination with the teachings of the other references are repeated here.

II. Claim 22 is amended to clarify the structural limitation that the finished strip be positioned and arranged into a rolled state along the longitudinal axis of the plastic strip.

Belt does not disclose a merchandising strip that is “positioned and arranged into a rolled state along the longitudinal axis” where the plastic strip includes “a plurality of pre-shaped adhesive elements, … each adhesive element capable of removably adhering to a discrete package of the plurality of discrete packages, the plurality of adhesive elements laminated on top of the surface of the second side of the strip of plastic, whereby the edges of the adhesive elements are exposed above the surface of the second side of the strip.” At the time the merchandising strip of Belt is created, Belt destroys the rolled state prior to creation of the merchandising strip. Upon application of the packaging to the newly created strip of Belt, Belt fails to disclose positioning and arranging the newly created merchandising strip into a rolled state. Belt, in combination with the other references, fails to meet all the limitations of the elements of the stated claim, as amended. In order to combine the references, the functionality of Belt is modified. *See*, MPEP §2143.01 VI, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The combination of Belt, Repaci, and Miles does not disclose, either alone or in combination, the limitations of the claim, as amended. The combination of Belt, Repaci, and Miles teaches away in several material respects, rebutting the *prima facie* case of obviousness.

III. Also, Claim 22 depends upon Claim 1 and should be allowable should the Examiner find Claim 1 to be allowable. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Claim 23.

The Office Action deems Claim 23 allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. Claim 23 depends upon Claim 22 which depends upon Claim 1 and should be allowable should the Examiner find either Claim 1 or Claim 22 to be allowable. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Claim 24.

The Office Action rejected claims 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Repaci et al. (USPN 6,109,852) in view of Miles (USPN 6,383,591), Bown et al. (USPN 5,366,777) and Belt (USPN 6,405,778). Applicant respectfully traverses this rejection.

I. The arguments and remarks as set forth from Claims 1 – 22 also apply for Claim 24.

II. Further, Applicant asserts that Bown does not teach pre-shaped adhesive elements. Bown teaches away in that Bown fails to disclose “a plurality of pre-shaped adhesive elements spaced from the longitudinal edges of the strip, said plurality of adhesive elements having an adhesive substance, each adhesive element capable of removably adhering to a discrete package of the plurality of discrete packages.”

Bown discloses in Col. 4 Lines 1ff:

Packages can be aggressively adhered to the display strip of this invention with a wide variety of adhesives, as it is contemplated that the package will not be removed from the detachable portion (11) of the fascia member. Such

"aggressive" attachment, by a relatively strong adhesive for example, also reduces the chance that packages will be inadvertently separated from the display strip either during shipping or at the point of display. Suitable adhesives include hot melt adhesives that are commercially available from a variety of sources including the H. B. Fuller Co.

As Bown contemplates that the package will not be removed, due to "aggressive" attachment by a "relatively strong adhesive", Bown clearly teaches away from the claim limitation "each adhesive element capable of removably adhering to a discrete package of the plurality of discrete packages."

Bown discloses in Col. 3 Lines 10ff:

Regardless of the precise manner in which the fascia is joined to the backing, a discrete portion of the fascia must be detachable from the display strip.

Bown fails to disclose that a "plurality of adhesive elements are laminated on top of the surface of said second side of said strip of plastic, whereby the edges of said adhesive element are exposed above the surface of said second side." Bown, therefore, cannot be used in combination with the other references, as such combination would be inoperable and would not meet the limitations of the present claim. Bown further teaches away in that Bown avoids "adhesive elements laminated on top of the surface of said second side of said strip of plastic" and avoids "edges of said adhesive element are exposed above the surface of said second side", instead disclosing that a "fascia is joined to the backing." Applicant's present invention eliminates the need for the fascia and eliminates the need for an "aggressive" attachment of a "detachable portion."

The references, when combined, do not produce the merchandising strip as claimed; it is not disclosed how to make a merchandising strip having all the limitations as set forth in the claim. *See, In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). *See, MPEP 2143.01(l)*. Further, the references, if combined, would change the principle

of operation of the Miller prior art invention. *See, In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). *See*, MPEP 2143.01(VI).

III. Claim 24 incorporates the limitations of Claim 1 and should be allowable should the Examiner find Claim 1 to be allowable. *See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). *See*, MPEP 2143.03.

Claim 25.

I. Claim 25 depends upon Claim 24 and should be allowable should the Examiner find Claim 24 to be allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

II. The arguments and remarks as set forth from Claims 1 – 22 and 24 also apply for Claim 25.

III. Claim 25 incorporates the limitations of Claim 1 and Claim 22 and should be allowable should the Examiner find either Claim 1 or Claim 22 to be allowable. *See, In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). *See*, MPEP 2143.03.

Claim 26.

The Office Action deems Claim 26 allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims. Claim 26 depends upon Claim 25 which depends on and Claim 24 and should be allowable should the Examiner find Claim 24 to be allowable. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Summary.

For all the above reasons, Applicant submits that the claims are now in proper form for allowance and that the claims all define patentably over the prior art. Therefore applicant submits that this application is now in condition for allowance and favorable action on the merits of this case is respectfully requested.

This Office Action is being filed with payment of Extension of Time fees. A supplemental Information Disclosure Statement is being filed with payment of fees. The Commissioner is hereby authorized to charge Deposit Account No. 01-2511 for any fees associated with this application, and to charge any additional filing fees or credit any overpayment to Deposit Account No. 01-2511.

Respectfully Submitted,



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